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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,088	09/19/2001	Tatsumi Matsumoto	016907-1295	9778

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FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,088

Applicant(s)

MATSUMOTO, TATSUMI

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/19/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "S1" has been used to designate both a sensor in Fig. 2 and a step in Fig. 5, reference character "S2" has been used to designate both a sensor in Fig. 2 and a step in Fig. 5, and reference character "S3" has been used to designate both a sensor in Fig. 2 and a step in Fig. 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "S11" is used in reference to Fig. 5 but does not appear in the figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

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drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In Fig. 2, reference characters (9), (34), and (55), Fig. 4, reference character (105), and Fig. 5, reference characters (S9) and (S12). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: On page 9, line 22, "28" should read "26", page 13, line 1, "50" should read "40", and page 15, line 11, "(step S4)" should read "(step S5)". Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0018227 to Asahi in view of U.S. Patent No. 5580045 to Matsumoto et al.

Regarding claim 1, Asahi discloses an image forming apparatus comprising: an original document table which sets an original document (see Fig. 3 and paragraph [0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7)), a print section which prints the image

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read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), a second key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), a control section which executes control of a first copy mode in accordance with an operation of the first key, control of the printer mode in accordance with an image input to the input section, and control of a second copy mode in accordance with an operation of the second key (see Fig. 1, paragraph [0022] lines 8-10, and paragraphs [0025] and [0033]), wherein in the control for the first copy mode, if the tray for the copy mode is set at the position corresponding to the discharge port when the first key is operated, the read section and the print section are immediately operated, or if the tray for the copy mode is not set at the position corresponding to the discharge port, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]), and in the control for the printer mode, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated, or if the tray for the printer mode is not set at the position

corresponding to the discharge port, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly in the control for the second copy mode, when the second key operated, the read section and the print section are immediately operated without moving each of the trays. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Matsumoto discloses a system of sorting different document types into different output bins containing a particular mode for forcibly discharging sheets into only the first bin (see column 12 lines 32-34 and column 15 lines 29-39).

Regarding claim 8, Asahi discloses a method of controlling the image forming apparatus including an original document table which sets an original document (see Fig. 3 and paragraph [0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7)), a print section which prints the image read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port

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which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), the method comprising a step in the first copy mode, if the tray for the copy mode is set at the position corresponding to the discharge port when the first key is operated, the read section and the print section are immediately operated, or if the tray for the copy mode is not set at the position corresponding to the discharge port, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]), and a step in the printer mode, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated, or if the tray for the printer mode is not set at the position corresponding to the discharge port, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly a step in the second copy mode, when the second key operated, the read section and the print section are immediately operated

without moving each of the trays. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Matsumoto discloses a system of sorting different document types into different output bins containing a particular mode for forcibly discharging sheets into only the first bin (see column 12 lines 32-34 and column 15 lines 29-39).

Regarding claim 11, Asahi discloses an image forming apparatus comprising: an original document table which sets an original document (see Fig. 3 and paragraph [0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7)), a print section which prints the image read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), a second key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), control for a first copy mode in which, if the tray for the copy mode is set at the position corresponding to the discharge port when the first key is operated, the read

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section and the print section are immediately operated, or if the tray for the copy mode is not set at the position corresponding to the discharge port, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]), and control means for the printer mode in which, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated, or if the tray for the printer mode is not set at the position corresponding to the discharge port, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly control means for the second copy mode in which, when the second key operated, the read section and the print section are immediately operated without moving each of the trays. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Matsumoto discloses a system of sorting different document types into different output bins containing a particular mode for forcibly discharging sheets into only the first bin (see column 12 lines 32-34 and column 15 lines 29-39).

Asahi & Matsumoto are combinable because they are from the same field of endeavor, printing documents to be output to different output bins depending on the type of job being processed.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the mode of forcibly discharging sheets to a particular bin as described by Matsumoto with the system of Asahi.

The suggestion/motivation for doing so would have been to provide the user with greater control of the output destination as well as increase the ease of collection of the document as the first bin is located at the top of the output bin unit.

Therefore, it would have been obvious to combine Matsumoto with Asahi to obtain the invention as specified in claims 1, 8, and 11.

Regarding claims 2, 6, and 12, Asahi and Matsumoto disclose the system discussed in claims 1 and 11, and Asahi further discloses wherein the sorter has an elevation unit for moving up and down each of the trays (see Fig. 2 and paragraph [0033]).

Regarding claims 3, 7, and 13, Asahi and Matsumoto disclose the system discussed in claims 1 and 11, and Asahi further discloses a control panel provided with the first and second keys (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]).

Regarding claims 4 and 14, Asahi and Matsumoto disclose the system discussed in claims 1 and 11, and Asahi further discloses a receiving section for a facsimile mode

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to receive an image which is facsimile-transmitted (see Fig. 1, paragraph [0021] lines 1-10, paragraph [0022] lines 1-2, and paragraph [0024]).

Regarding claim 5, Asahi and Matsumoto disclose the system discussed in claim 1, and Asahi further discloses wherein the print section further prints the image received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]), and the sorter further executes control for the facsimile mode, and in the control for the facsimile mode, if the tray for the facsimile mode is set at the position corresponding to the discharge port when an image is received by the receive section, the print section is immediately operated, or if the tray for the facsimile mode is not set at the position corresponding to discharge port, the tray for the facsimile mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion (see paragraphs [0025] and [0033]).

Regarding claim 9, Asahi and Matsumoto disclose the system discussed in claim 8, and Asahi further discloses wherein the apparatus comprises a receiving section for a facsimile mode to receive image which is facsimile-transmitted (see Fig. 1, paragraph [0021] lines 1-10, paragraph [0022] lines 1-2, and paragraph [0024]), the print section further prints the image received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]).

Regarding claim 15, Asahi and Matsumoto disclose the system discussed in claim 14, and Asahi further discloses wherein the print section further prints the image

received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]).

Regarding claims 10 and 16, Asahi and Matsumoto disclose the system discussed in claims 9 and 15, and Asahi further discloses in the control for the facsimile mode, if the tray for the facsimile mode is set at the position corresponding to the discharge port when an image is received by the receive section, the print section is immediately operated, or if the tray for the facsimile mode is not set at the position corresponding to discharge port, the tray for the facsimile mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion (see paragraphs [0025] and [0033]).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers 5742890 (Kato et al.) and 6636323 (Suzuki et al.) and U.S. Patent Application Publication numbers 2002/0057445 (Sukuki et al.) and 2003/0016377 (Katahira).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622

